

REMARKS

A restriction requirement was issued in this case on February 7, 2006. The action requires restriction of the claims to one of the following seven alleged separate inventions:

1. Claims 1-4, drawn to a method of organizing a desktop;
2. Claims 5-21, drawn to a desktop file organizer;
3. Claims 22-23 and 26, drawn to a desktop filing organizer;
4. Claim 24, drawn to a desktop filing organizer;
5. Claims 27, 29, and 30, drawn to a file organizer and carrying case;
6. Claim 31, drawn to a method of organizing a filing system; and
7. Claim 32-33, drawn to a desktop filing system.

In response, the applicants elect **Group 2, claims 5-21**. However, **this response is with traverse**, because the Office has not shown that the inventions of Groups 4 and 5 are separate inventions from the invention of Group 2 under the procedure outlined in the MPEP.

Restriction of Group 4, Claim 24 from Group 2, Claim 5 is Improper.

As outlined in the Restriction Requirement, claim 24 is a subcombination of combination claim 5. All of the elements of claim 24 are recited in claim 5. “Where a combination *as claimed* sets forth the details of the subcombination *as separately claimed*, there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.” MPEP § 806.05(c).

Here, the subcombination claim 24 is separately claimed, and the combination claim 5 sets forth the details of the subcombination claim 24. Accordingly, Group 4 is not distinct from Group 2, and Group 4 should be examined as well.

Restriction of Group 5, claim 27, from Group 2, claim 5 is Improper.

The Office action alleges that claim 5 is a subcombination of the combination claim 27, and alleges that claim 5 has “separate utility such as use without a handle.” While claim 5 does not recite a handle, and claim 27 does recite a handle, this is not a “**separate utility.**” Utility does not refer to the claimed elements, it refers to how the claimed subject matter is used. Thus, the invention of claim 27 can be used by being transported to a second location while being “carried via the handle.” However, the invention of claim 5 can also be carried to a second location, even without a handle. Accordingly, the Office has not shown that the subcombination of claim 5 can be used in a manner that is different than the combination of claim 27 based on the differing claim elements. Thus, no distinctiveness of claim 5 relative to claim 27 has been shown. Accordingly, this aspect of the restriction requirement is improper and must be withdrawn.

No Showing Has Been Made That Each Group is Patentable over the Disclosure of the Other Groups.

35 U.S.C. § 121 states that restriction is only proper when “two or more independent and distinct inventions are claimed in one application.” MPEP § 802.01 outlines that distinctness can only be found when “two or more subjects as disclosed... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER” (emphasis in original).

Thus, in this restriction requirement, the Office is admitting that the claims of Group 2 are patentable over the disclosure of Groups 4 and 5. Likewise, it admits Group 4 is patentable over the disclosure of Groups 2 and 5, and Group 5 is patentable over the disclosure of Groups 2 and 4. Thus, the Office is admitting that the file organizer of claim 5 is

patentable over a disclosure of a file organizer as recited in claims 24 and 27. This position is necessary for entry of the restriction requirement by the Patent Office.

If the restriction requirement is upheld, the applicants can and will rely on this admission during examination of this application and any continuing or divisional applications. If this position is not to be taken by the Patent Office, then the applicants request that the restriction requirement be withdrawn.

CONCLUSION

In view of this response, applicants request substantive examination of claims 5-21, 24, 27, 29, and 30. Because these claims were shown to be allowable in the most recent Amendment filed November 23, 2005, applicants respectfully request a notice of allowance to at least these claims.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 13-2855, under Order No. 29618/EL013 from which the undersigned is authorized to draw.

Dated: March 7, 2006

Respectfully submitted,

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